

### **REMARKS/ARGUMENTS**

Claims 1-10 are pending in the application. Claims 1-4 and 7-9 were withdrawn by the Examiner from further consideration in this application as being directed to non-elected inventions. The remaining claims, i.e., nos. 5, 6 and 10 are rejected.

In this response, the text of the specification has been amended at pp. 3-4 to change, “chosen from the set consisting of” to the proper Markush terminology, i.e., “chosen from the group consisting of”. No new matter is added due to this change.

Further to the above, all of the pending claims, i.e., nos. 1-10, are canceled without prejudice or disclaimer and replaced by new claims 11-14. The new claims are supported by the application as filed and thus there is no issue of new matter. The new set of claims is restricted to the compound of Example 8 and to mixtures containing this compound, i.e., namely the mixtures of Example 1 (the Ia/IIa/IIIa 10/85/5 weight mixture) and Example 4 (the Ia/IIa 80/20 weight mixture). As the claims are directed to the same invention that has already been searched by the Examiner, their entry into the file of this application is respectfully requested. Upon such entry, claims 11-14 will be pending in the application.

Reconsideration of the application is respectfully requested.

### **Claim Objections**

Claims 5 and 6 are objected to due to certain ‘informalities’ as described on p. 2 of the Action. However, the cancellation of the subject claims from the application, without prejudice or disclaimer, is believed to render the claim objections moot. The objections should, therefore, be withdrawn.

### **Claim Rejections Under 35 U.S.C. §112**

Claim 10 is rejected under 35 U.S.C. §112, second paragraph, due to alleged indefiniteness. Claim 10 has been cancelled (without prejudice or disclaimer) from the application, thus rendering this rejection moot. Furthermore, the proposed new claims 11-14 submitted herewith do not contain the language objected to by the Examiner in claim 10. The Examiner is thus requested to reconsider and withdraw the rejection under paragraph 2 of 35 U.S.C. §112.

Further to the above claim 10 is also rejected under 35 U.S.C. §112, first paragraph (see, e.g., pp. 3 and 6 of the Office Action), due to an alleged lack of enablement. As in the matter of the §112, paragraph 2 rejection discussed above, the cancellation of the rejected claim (without prejudice or disclaimer) is also deemed to render moot the rejection under paragraph 1 of §112. Furthermore, the proposed new claims 11-14 provided herewith are all believed to be entirely enabled by the teaching set forth in the specification of the application. As such, the Examiner is respectfully requested to reconsider and withdraw the §112, paragraph 1 rejection as well.

### **Claim Rejections Under 35 U.S.C. §103**

Claims 5 and 10 are rejected under 35 U.S.C. §103 as being allegedly unpatentable over Kojo et al. [*sic.* Watanabe et al.] EP 0 633 022 A2 for the reasons set forth at pp. 10-13 of the Office Action. The cancellation of the rejected claims, however, without prejudice or disclaimer, renders this rejection moot as well and thus it should be withdrawn.

Further to the above, applicants submit that the proposed new claims, i.e., nos. 11-14 are not 'obvious' over the cited reference. As taught in the present specification, the compound of Example 8 and the mixtures containing this material as set forth in Examples 1 and 4, are useful in cosmetics (see assays F on p. 19). They additionally possess anti-free radical properties (see assays G on pp. 19-20 and Fig. 1), which properties are useful both in cosmetics and therapeutic agents. The Watanabe et al. reference neither discloses nor even suggests: (1) the compound of Example 8 and/or the mixtures described in Examples 1 and 4; or (2) the use, in particular, of such material as anti-free radical agents. More particularly:

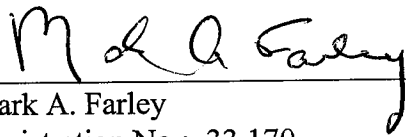
- the list of products set forth in Table 1 of Watanabe et al. does not include any genkwanin substance;
- formula I of Watanabe et al. does not include within its scope the value  $R^8 = \text{ethoxy}$  since the reference teaches that  $R^1$  to  $R^9$  are, independently, a hydrogen atom, a hydroxyl group or a methoxyl group;
- as noted by the Examiner in the Office Action, the oside group of the genkwanin derivative in accordance with the present invention is not specifically exemplified in Table I of the Watanabe et al. reference; and
- the genkwanin derivative according to the present invention is proposed for cosmetic or

therapeutic use, which is an entirely different use than the chondroprotective use envisaged for the compounds described for use in the cited prior art.

In sum, therefore, the cited reference fails to teach or suggest the genkwanin derivative as presently claimed, or the mixtures recited in the dependent claims, nor does the subject reference disclose the specific cosmetic and/or therapeutic properties of the presently claimed materials. Applicants thus respectfully submit that the compositions recited in the new claims 11-14 are thus entirely distinguishable over the Watanabe et al. reference cited to reject applicants' original claims 5 and 10 and the claim rejection under 35 U.S.C. §103 based on the cited reference should be withdrawn.

THIS CORRESPONDENCE IS BEING  
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Respectfully submitted,



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